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NGUYEN, PHONG H

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/697,554
Filing Date: October 31, 2003
Appellant(s): JOHNSON ET AL.

Benjamin L. Kiersz
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 04/22/2009 appealing from the Office action mailed 12/22/2008.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,992,023	SEDERBERG ET AL.	11-1999
5,894,666	HRUSCH	04-1999
402,381	AIKEN	04-1889
5,187,868	HALL	02-1993
6,839,969	JACOBSON ET AL.	01-2005

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-22, 40-49, 51, 53 and 55-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sederberg et al. (5,992,023), hereinafter Sederberg, in view of Hrusch (5,894,666), Aiken (402,381), Jacobson et al. (6,839,969), hereinafter Jacobson, and Hall (5,187,868).

Sederberg teaches a metal demolition shears comprising a fixed jaw 14 having a fixed blade 66 with a first cutting/shearing edge, a movable jaw 16 having a second cutting/shearing edge (formed by blade 116) and a wear plate/piercing tip insert 140 having one cutting tip 144. See Figs. 1-14.

Sederberg fails to teach the geometric configuration of the wear plate/pierce tip insert 140 being the same in a first position and a second position, wherein the second position is a position in which the wear plate/tip insert is rotated 180 degrees.

It is well known to one skilled in the art to make a geometric configuration of a wear plate/pierce tip insert being the same in a first position and a second position,

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wherein the second position is a position in which the wear plate/tip insert is rotated 180 degrees to prolong the useful life of the wear plate/pierce tip insert. For example, Hrusch teaches a geometric configuration of the wear plate/pierce tip insert 88 (Fig. 4) being the same in a first position (top tip) and a second position (left of right tip), wherein the second position is a position in which the wear plate/tip insert is rotated 180 degrees. Aiken teaches a geometric configuration of a wear plate/pierce tip insert 2 (Fig. 3) and a shear blade (a) (Fig. 5) being the same in a first position and a second position, wherein the second position is a position in which the wear plate/tip insert is rotated 180 degrees. Sederberg teaches the geometric configuration of a shearing blade 116 (Fig. 13 and 14) being the same in the first position and the second position wherein the second position is a position in which the shearing blade is rotated 180 degrees.

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to provide the wear plate/pierce tip insert 140 a symmetrical body so that both ends of the wear plate/pierce tip insert 140 can be used by rotating the wear plate/pierce tip insert 140 as taught by Hrusch, Aiken and Sederberg to prolong the useful life of the wear plate/pierce tip insert.

It is to be noted that when a second cutting tip is provided to the wear plate/pierce tip insert, it would have been obvious to one skilled in the art not to expose the second cutting tip above the top of the moveable jaw 16 to interfere with the function of pulling roots of the moveable jaw. For example, Hrusch teaches several of reverseable wear plate/pierce tip inserts wherein the non-used tips are not exposed above the moveable

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jaw. Jacobson and Hall teach wear plate/pierce tip inserts (110 in Jacobson and 14 in Hall) wherein the non-used ends are not exposed above the moveable jaw.

(10) Response to Argument

A. Independent claims 1, 3, and 42 and dependent claims 2, 43-49, and 51.

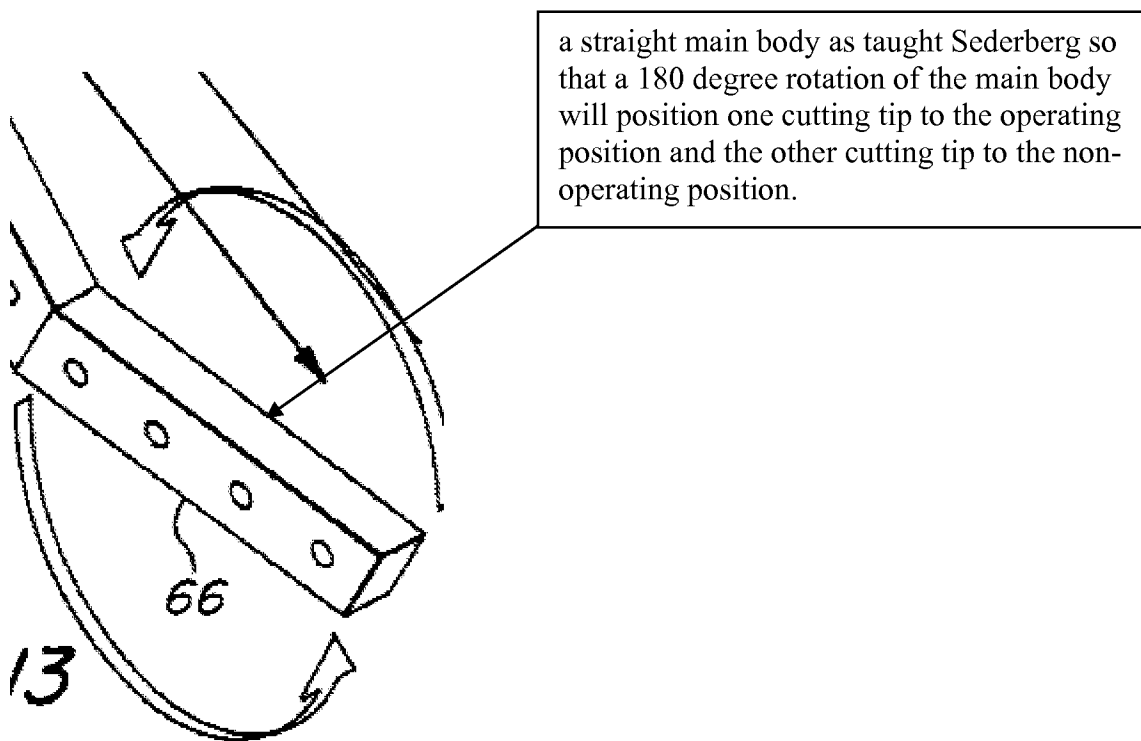
1. There was no disclosure, suggestion, or other reason to make the proposed modification.

The Applicant argues that since the structure of the indexable tip insert 140 in Sederberg is more complicate than the indexable tip inserts in Hrusch and Aiken such as the bosses 150 and the cutting tip 144 projecting laterally with respect to the main body 142 of the indexable tip insert 140, it would not have been obvious to one skilled in the art to make the proposed modification. This argument is not persuasive.

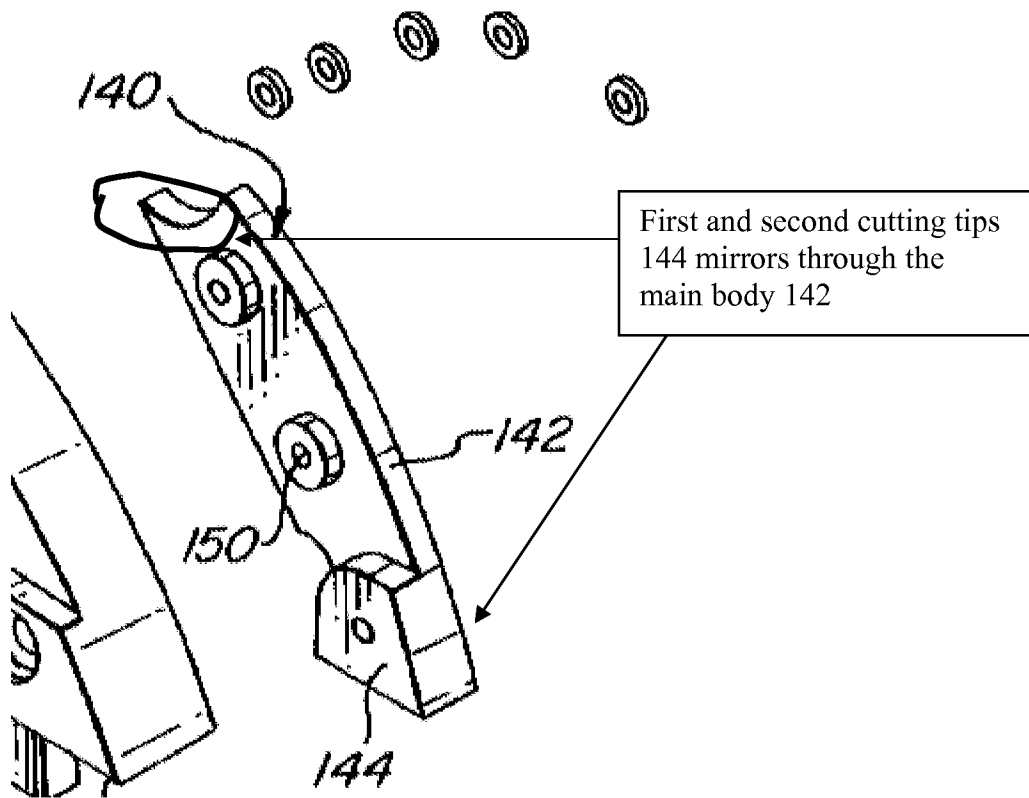
Sederberg teaches the tip insert 140 substantially as claimed except for a second cutting tip 144 and the main body 142 being configured so that a 180 degree rotation of the main body 142 will expose one cutting tip 144 at an operating position and store the other cutting tip 144 at a non-operating position. The concept of provide an symmetrical main body so that an 180 degree rotation of the main body will expose one cutting tip at an operating position and store the other cutting tip at a non-operating position is well known in the art as evidenced in Figs. 13 and 14 in Sederberg, in Figs. 3 and 5 in Aiken, and Figs. 6, 7 and 10 in Hrusch. Therefore, it would have been obvious to one skilled in the art to provide a second cutting tip 144 and to configure the main body 142 so that a 180 degree rotation of the main body 142 will expose one cutting tip 144 at an operating position and store the other cutting tip 144 at a non-operating position based on teachings of Sederberg, Aiken and Hrusch. When the second cutting tip is incorporated into

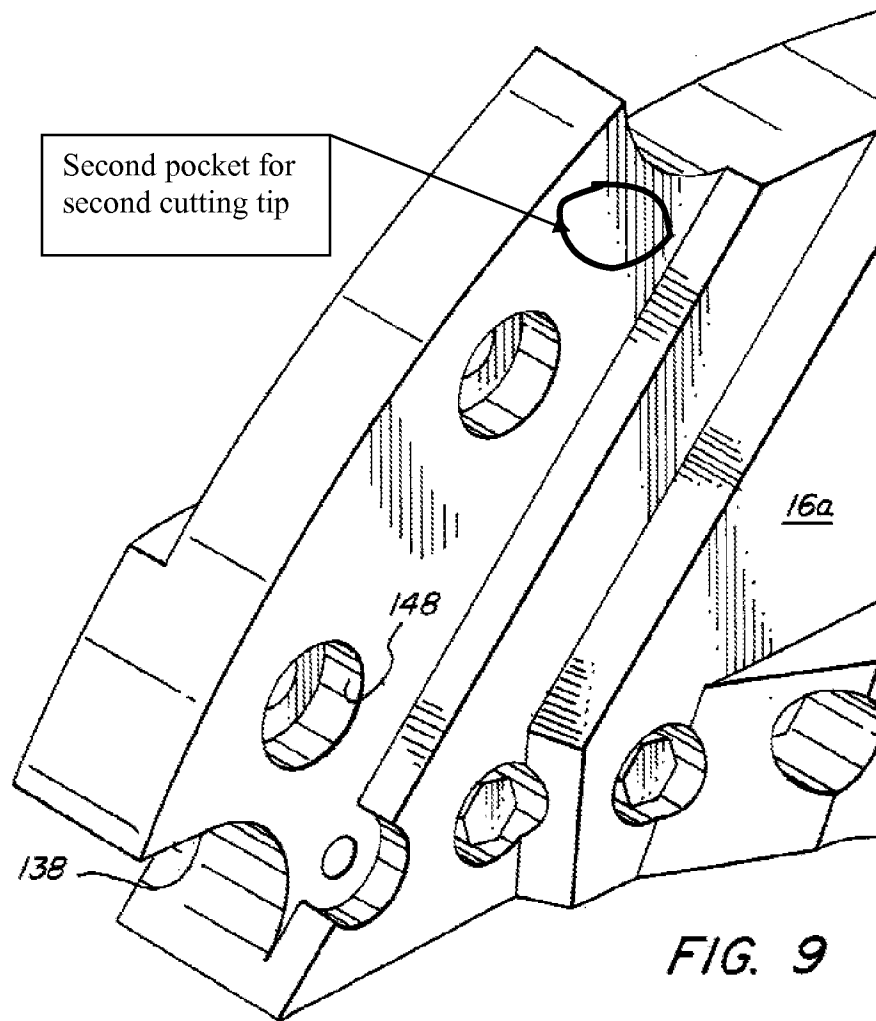
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the main body as taught by Sederberg, Aiken and Hrusch, it is within the knowledge of one skilled in the art to (a) configure the second cutting tip so that the second cutting tip mirrors the first cutting tip through the main body as taught by Aiken, (b) to provide a straight main body as taught Sederberg so that a 180 degree rotation of the main body will position one cutting tip to the operating position and the other cutting tip to the non-operating position, (c) a pocket on the upper jaw for storing the second cutting tip.



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2. Hrusch and Aiken do not cure the deficiencies of Sederberg.

The Applicant argues that Hrusch and Aiken do not teach providing a second cutting tip to Sederberg. This argument is not persuasive. Hrusch and Aiken teach providing a second cutting tip to Sederberg as explained above.

3. The proposed modification relies on impermissible hindsight.

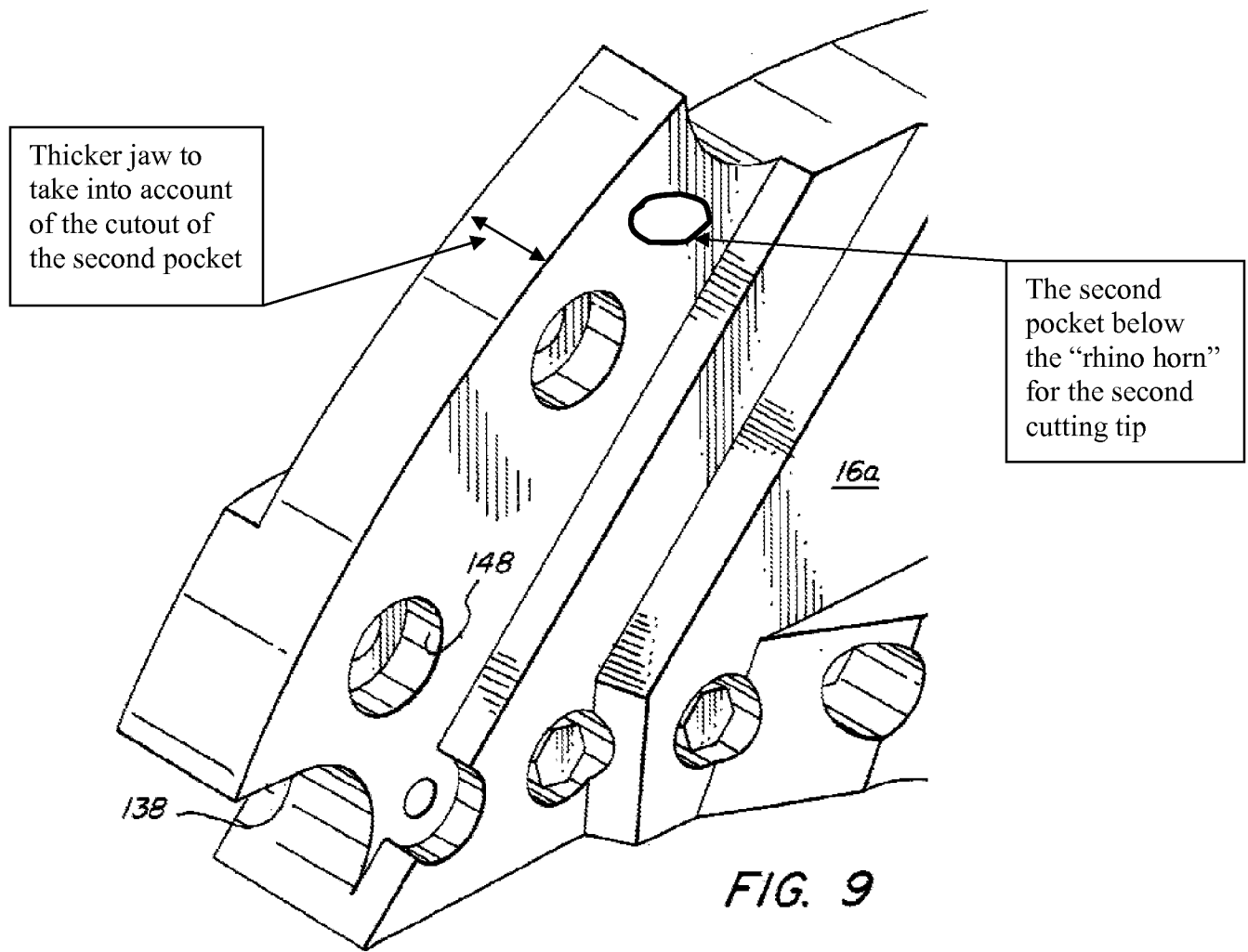
The Applicant argues that it is hindsight to combination Sederberg, Aiken and Hrusch. In response to applicant's argument that the examiner's conclusion of obviousness is based upon

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improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

4. Sederberg teaches away from the proposed modification.

The Applicant argues that the proposed modification destroy the “rhino horn” of the shear assembly; and the proposed modification weakens the structure of the jaw due to provide a second pocket for the second cutting tip. This argument is not persuasive. Hrusch, Jacobson and Hall teach that the non-used cutting tips are not exposed above the jaws. Therefore, it would have been obvious to one skilled in the art to provide a second pocket for the second cutting tip below the “rhino horn” and a thicker jaw to take into the account of the cutout of the second pocket. Even though without the teaching of Hrusch, Jacobson and Hall, positioning the second cutting tip 144 below the “rhino horn” so that the second cutting tip does not interfere with the "rhino horn" is within the knowledge of one skilled in the art since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70 (CCPA 1950).



5. The objective evidence of non-obviousness is compelling.

a. The commercial success of the invention proves it non-obviousness.

In paragraph 6 of the declaration under 37 CFR 1.132, the Applicant states that since the sales of MSD Saber Series which have the claimed indexable cutting insert increases at least 96%, there is a commercial success of the claimed indexable cutting insert. This statement is not persuasive. The Applicant does not establish any meaningful data to compare the sale of the

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claimed indexable cutting insert and the cutting insert in Fig. 10 in Sederberg. Stanley LaBounty dropped the cutting insert in Fig. 10 in Sederberg from the marketing and sale (see paragraph 3) to promote the claimed indexable cutting insert. Therefore, the increase in sale may be due to lack of availability of other cutting insert series from Stanley LaBounty but not the two cutting tips of the cutting insert. The increase in sale also may be due to a boom in construction industry that needs more cutting inserts or a good marketing strategy.

b . Competitor's copying of the invention and subsequent respect for the value of the claimed invention proves its nonobviousness.

The Applicant argues that since Genesis and Trevi Benne have copied and infringed the indexable cutting insert, it demonstrates its nonobviousness. This argument is not persuasive.

Regarding the Genesis' case, Genesis made indexable cutting inserts for Stanley's MSD Saber Series (see paragraph 10 of the declaration under 37 CFR 1.132 and Exhibit D) but not for any Genesis' shears. Therefore, Genesis' copying case is merely due to economical reason than the inventive concept of an indexable cutting tip. For example, Stanley LaBounty's cutting inserts have been expensive and not available enough on the market. Therefore, Genesis would have tried to make cheaper ones to sale for less to meet the market demand.

Regarding the Trevi Benne's case, Trevi Benne made and sold indexable cutting insert in 2000 (see Exhibit F and Exhibit H, paragraph (a)) while the claimed cutting inserted was invented in 10/31/2003. Therefore, Trevi Benne's cutting insert is an evidenced that to provide a second cutting tip to the cutting insert of Sederberg is within the knowledge of one skilled in the art.

c . The European Patent Office found the invention patentable

The Applicant argues that since European Patent Office (EPO) granted a patent (EP 1,682,299) to a similar invention owned by the Applicant, it is an evidence of unobviousness. This argument is not persuasive. US Patent and Trademark Office (USPTO) and European Patent Office are two independent offices and each has its own set of rules to examine patent applications. What is obvious at USPTO may not be obvious at EPO and vice versa. Furthermore, the claims in EP 1,682,299 are not identical to the claims in the current patent application. Therefore, it is premature to assert the unobviousness of the current patent application based on EP 1,682,299.

B. Independent claim 4 and dependent claims 40 and 41

The Applicant argues that claim 4 is allowable for the same reason as discussed in claims 1, 3 and 42; and claims 40 and 41 should be allowable because they depend on claims 4. These arguments are not persuasive. Claims 1, 3 and 42 are not allowable for reasons explained above. Therefore, claim 4 is not allowable. Since claim 4 is not allowable, claims 40 and 41 are not allowable.

C. Independent claims 5, 7, 10, 12, 14, 16, 18 and 20 and dependent claims 6, 8, 9, 11, 13, 15, 17, 21, 22, 53 and 55-57

The Applicant argues that claims 5, 7, 10, 12, 14, 16, 18 and 20 are allowable for the same reason as discussed in claims 1, 3 and 42; and claims 6, 8, 9, 11, 13, 15, 17, 21, 22, 53 and 55-57 should be allowable because they depend on claims 5, 7, 10, 12, 14, 16, 18 and 20 . These arguments are not persuasive. Claims 1, 3 and 42 are not allowable for reasons explained above. Therefore, claims 5, 7, 10, 12, 14, 16, 18 and 20 are not allowable. Since claims 5, 7, 10, 12, 14,

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16, 18 and 20 are not allowable, claims 6, 8, 9, 11, 13, 15, 17, 21, 22, 53 and 55-57 are not allowable.

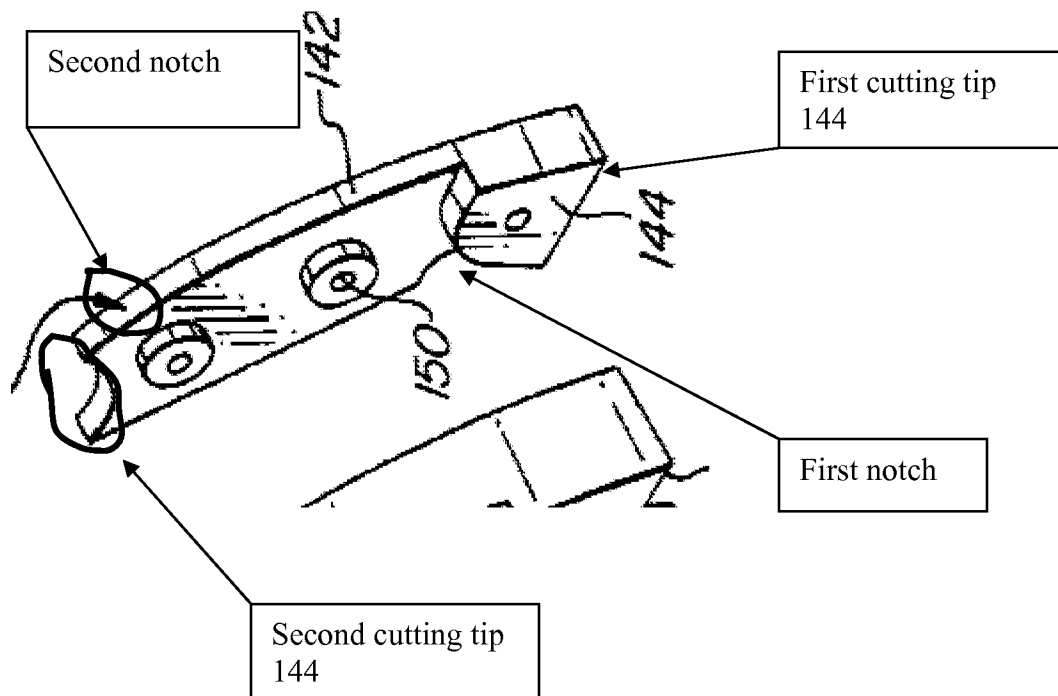
D. Independent claim 19

The Applicant argues that claim 19 is allowable for the same reason as discussed in claims 1, 3 and 42. This argument is not persuasive. Claims 1, 3 and 42 are not allowable for reasons explained above. Therefore, claim 19 is not allowable.

E. Dependent claim 46

The Applicant argues that the cited prior art does not teach “a first notch extends into the central region from the first generally planar edge surface,” and “a second notch extends into the central region from the second generally planar edge surface”. This argument is not persuasive. Sederberg teaches a first notch at the right bottom side of the main plate 142. When the second cutting tip 144 is added to the left end of the main plate as taught by Sederberg (Figs. 13 and 14), Aiken and Hrusch, the second notch is provided at the upper left side of the main plate 142 so that when the main plate 142 is rotated 180 degrees to move the second cutting tip to the operating position, the second cutting tip 144 will match with the contour and profile of the upper jaw that receives the first cutting tip 144.

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Additionally, the Applicant argues that claim 46 is allowable for the same reason as discussed in claims 1, 3 and 42. This argument is not persuasive. Claims 1, 3 and 42 are not allowable for reasons explained above. Therefore, claim 46 is not allowable.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Phong H Nguyen/
Examiner, Art Unit 3724
July 14, 2009

Conferees:

Art Unit: 3724

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